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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/491,888	10/10/95	RIGLER	R 10496/P5884

18M1/0415  
JACOBSON PRICE HOLMAN & STERN  
400 SEVENTH STREET NW  
WASHINGTON DC 20004

EXAMINER
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BAKALYAR, H

ART UNIT	PAPER NUMBER
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1818 10

DATE MAILED: 04/15/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 7/18/95

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-84 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-84 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

Art Unit: 1818

*Election/Restrictions*

1. This application contains the following inventions or groups of inventions which are not so linked as to form a single inventive concept under PCT Rule 13:

- a. Group I, claim(s) 1-46 and 69, drawn to a method of identifying molecules
- b. Group II, claim(s) 47-65, drawn to a device for identifying molecules
- c. Group III, claim(s) 66-68, drawn to a method of identifying microorganisms
- d. Group IV, claim(s) 70, drawn to a device with a multiarray detector
- e. Group V, claim(s) 71-84, drawn to a device for detection of molecules

2. The inventions are distinct, each from the other because of the following reasons:

a. A national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application will be considered as the main invention in the claims, see PCT article 17(3) (a) and 1.476 (c), 37 C.F.R. 1.475(d).

b. The inventions listed as Groups I/III and Groups II/IV/V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the devices of Groups

Art Unit:

are not specifically designed for carrying out the methods of Groups I/III, the contribution over the prior art of the devices does not correspond to the contribution over the prior art for the methods (see MPEP App AI (Administrative Instructions Under the PCT) part (e) page AI-39, left column). For example, independent claim 47 describes the optics of the claimed device as known; independent claim 70 does not recite the method of Groups I/III; independent claim 71 has been cited as not novel over BBA (1980) 615 pages 28-46 and European Biophysics Journal, (1985) 12(3) pages 163-166, in particular Figures 1 and 3, respectively.

c. The inventions listed as Groups II, IV and V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the devices of Groups II, IV and V do not share a special technical feature as independent claim 70 does not recite a purpose or physical feature in common with Groups II and V, independent claim 71 recites a device for the detection of one or more molecules and independent claim 47 recites a device for identification of a molecule.

d. The inventions listed as Groups I and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: no common feature of Group I and Group III could be found.

Art Unit:

3. Because these inventions are distinct for the reasons given above restriction for examination purposes as indicated is proper.

4. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Group I, claims 1-46 and 69 -:

- a. species I: space coordinates
- b. species II: composition of analyte
- c. species III: enhancement of detection
- d. species IV: uses

Applicant is required, in response to this action, to elect a single species for each of a-d to which the claims shall be restricted if no generic claim is finally held to be allowable. The response must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

5. The claims are deemed to correspond to the species listed above in the following manner:

- a. species I: space coordinates
  - (1) claim 3, space coordinates are changed

Art Unit:

- (2) claim 69, space coordinates are not changed
- b. species II: composition of analyte
  - (1) claim 34, in vitro synthesized protein
  - (2) claims 33 and 35, vesicles
  - (3) claims 11, 17 and 23-27, nucleic acid .
  - (4) claims 18-21, pharmacologically active ligand/receptor
- c. species III: enhancement of detection
  - (1) claim 28, effective association rate
  - (2) claim 29, increase difference in size/shape
  - (3) claim 30, ternary complex
- d. species IV: uses
  - (1) claim 39
  - (2) claim 40
  - (3) claim 41
  - (4) claim 42
  - (5) claim 43
  - (6) claim 44
  - (7) claim 45
  - (8) claim 46

Art Unit:

6. The following claim(s) are generic: claim 1

7. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: species a lacks common technical feature in regard to the constancy of the space coordinates; the analytes of species b are structurally and functionally dissimilar; the methods of enhancement of species c do not share a common technical feature; the uses of species d do not share a common technical feature.

8. A telephone call was made to Harvey Jacobson on 4/4/97 to request an oral election to the above restriction requirement, but did not result in an election being made.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

10. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Art Unit:

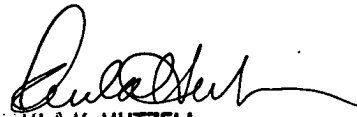
11. Any inquiry concerning this communication should be directed to Heather Bakalyar at telephone number (703)305-7143.

The examiner can normally be reached on Monday through Friday from 9:00 am to 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, Ph.D., can be reached on (703) 308-4310. The fax phone number for this Group is (703)305-7939.

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1800 receptionist whose telephone number is (703)308-0196.

Heather Bakalyar, Ph.D.

4/4/97

  
PAULA K. HUTZELL  
SUPERVISORY PATENT EXAMINER  
GROUP 1800